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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,650	08/11/2000	Chao-Feng Zheng	25436/1510	7825

7590 12/04/2001
Palmer & Dodge LLP
One Beacon Street
Boston, MA 02108

EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 12/04/2001

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,650

Applicant(s)

ZHENG, CHAO-FENG

Examiner

Terry Mckelvey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: *Beta Adams*

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DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 24-26, drawn to cell line and kit, classified in class 435, subclasses 325, 243, and 410.
- II. Claims 10 and 14-16 (as they apply to claim 10), drawn to method of assaying for the activity of a pathway, classified in class 435, subclass 6.
- III. Claims 11-16 (as they apply to claim 11), drawn to method of screening for a modulator of a pathway, classified in class 435, subclass 6.
- IV. Claims 17 and 21-23 (as they apply to claim 17), drawn to method of assaying for the activation of a conditionally active transactivation domain, classified in class 435, subclass 6.
- V. Claims 18-23 (as they apply to claim 18), drawn to method of screening for a modulator of the activity of a conditionally active transactivation domain, classified in class 435, subclass 6.

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VI. Claims 27 and 29-32 (as they apply to claim 27), drawn to method of assaying for the interaction of two proteins, classified in class 435, subclass 6.

VII. Claims 28-32 (as they apply to claim 28), drawn to method of screening for a modulator of the interaction of two proteins, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Groups II-VII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the cell line of Group I can be used in a materially different process as evidenced by the distinct inventions of Groups II-VII.

Inventions of Groups II-VII are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups II-VII comprise steps which are not required for or present in the methods of the other groups. The end result of the methods are

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different: assay of the activity of a pathway (Group II), screened modulator of a pathway (Group III), assay of the activation of a conditionally active transactivation domain (Group IV), screened modulator of the activity of a conditionally active transactivation domain (Group V), assay of the interaction of two proteins (Group VI), and screened modulator of the interaction of two proteins (Group VII). Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for Groups II-VII are not required for the other groups with regard to the non-patent literature because an examination of each group requires a search for the method step(s) unique to each group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Conclusion

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning missing attachments or other minor formalities of this communication should be directed to the patent analyst, Zeta Adams, whose telephone number is (703) 305-3291.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Dr. Robert Schwartzman, can be reached on (703) 308-7307.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Terry A. McKelvey, Ph.D.
Primary Examiner
Art Unit 1636

December 3, 2001